



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 088941/0182

Applicant: Yuji TSUKAMOTO

Title: DIGITAL CONTENTS RENTAL SYSTEM

Serial No.: 09/771,702

Filed: January 30, 2001

Examiner: Unknown

Art Unit: 2614

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**INFORMATION DISCLOSURE STATEMENT  
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Submitted herewith on Form PTO SB/08 is a listing of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any documents herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a prima facie prior art reference against the claims of the present application.

**TIMING OF THE DISCLOSURE**

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

**CERTIFICATION**

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that items of information A2 - A4 listed on the Form PTO SB/08 submitted with this Information Disclosure Statement were first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement. Item of information A1 is a U.S. patent that is a counterpart to item of information A3 (which is a laid open Japanese patent application).

**RELEVANCE OF EACH DOCUMENT**

A translation of a portion of a Japanese Office Action that issued March 4, 2003 with respect to a counterpart Japanese patent application is provided below.

**"Reason**

The invention related to the following claims of this application is based on inventions cited in the following publications that had been circulated prior to this application in Japan or a foreign country. Because a person having ordinary knowledge in the technical field to which that invention belongs could have easily made the invention prior to this application, a

patent cannot be granted pursuant to the stipulations of Article 29, Section 2 of the Japan Patent Law.

#### Note

(For a list of the cited literature, see the List of Cited Literature.)

Claims: 1 through 12

Cited Literature: 1 through 3

#### Remarks

Described in Cited Literature 1 is a media rental shop that forwards media information from a media center (Corresponds to the "Content" in the invention of the present application.), records the said media information on package media (Corresponds to the "Recorded medium" in the invention of the present application.) using a high speed media recording device, and provides a means to rent the said package media.

Moreover, described in Cited Literature 2 is a means to restrict use based on the use period and use frequency of the rented content (Claims 2 through 6 of the present invention), and described in Cited Literature 3 is a means that stores advertising information within the said content, and that bills the user and the advertising information provider corresponding to the frequency of using the said advertising information (Claims 7, 8, 11 of the present application), and a means to bill the user and the content provider corresponding to the frequency of using the said content (Claims 9 and 10 of the present application).

Consequently, the inventions related to Claims 1 through 12 of the present application could have been easily conceived by a person skilled in the art based on the descriptions in aforementioned Cited Literature 1 through 3.

If new reasons for rejection are discovered we will notify you of the reasons for rejection.

#### List of Cited Literature

1. Japanese Unexamined Patent Application Publication H05-067271
2. Japanese Unexamined Patent Application Publication H11-272762
3. Japanese Unexamined Patent Application Publication H09-046453

## Record of Prior Art Literature Search Results

Fields searched - G06F 17/60  
Prior art literature"

Applicant's statements regarding the Japanese Office Action are based on a partial translation that Applicant's representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Japanese Office Action.

Applicant respectfully request that the listed document be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

8 April, 2003  
Date

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